

### **REMARKS**

This Amendment and Response is submitted in response to the September 3, 2004, Office Action.

In view of the continued reference in the Office Actions to Regulations which no longer exist, Applicant has revised the specification to omit any reference to numeral 30, thus overcoming the objections to the drawings and obviating any need to amend Figure 2.

In the September 3, 2004, Office Action, paragraphs 7-9, the Examiner rejected all then pending claims. By this Amendment and Response, Applicant has cancelled all rejected claims and added new claim 68-80. Cancellation of these previously pending claims was not made in response to, and is not to be construed as made in response to, the Examiner's rejections. Applicant specifically reserves the right to continue pursuit of the cancelled claims in Applicant's sole discretion.

The Examiner rejected all previously pending claims under 35 U.S.C. § 251 as being "an improper recapture of claimed subject matter because the claim language is directed to subject matter surrendered in the original application by changes made to the claims in an effort to overcome a prior art rejection and/or arguments made in an effort to overcome the prior art". In support of this rejection, the Examiner relies specifically on the following claim language which was added by amendment during prosecution of the original patent:

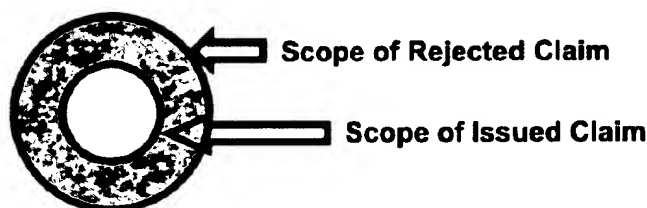
1. "for attaching to a firearm, said firearm having a firing end and a grip end, and",  
added to the preamble of issued claim 1 (original application claim 1).
2. "wherein said first means comprise an inertia switch comprising a movable mass;  
and wherein said mass is resiliently biased toward the firing end of the firearm"  
added to issued claims 1 and 14 (original application claims 1 and 12).

The Examiner also relies upon "arguments filed on 2/20/96 directed to 'the moveable mass is resiliently biased toward the firing end of the firearm'".

The Examiner's recapture rejection in the September 3, 2004, Office Action, is taken verbatim from part of paragraph 15 of the November 11, 2000. Although the previously pending claim have been cancelled, and the newly added claims have not been examined, Applicant herein addresses the erroneous application of the recapture doctrine in the previous Office Actions.

In the years between the two Office Actions, and subsequent to the cases cited in the November 11, 2000 and September 3, 2004, Office Actions, the Board of Patent Appeals rendered its decision in *Ex parte Eggert*, 67 U.S.P.Q. 2d 1716 (Bd. Of Patent Appeals and Interferences, 2003), completely in accordance with Applicant's statement of the recapture rule as set forth in Applicant's previously submitted Remarks.

The BPAI summarized the recapture rule as "[a] patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation or argument of claims for the purpose of obtaining the original patent". *Id.* at 1723. The BPAI made it clear that the scope of surrendered subject matter is defined entirely by the scope of the "claim from which the issued claimed (sic) directly evolved, not the issued claim itself", *Id.* at 1718, using the following drawing to explain the scope of surrendered subject matter:



**Drawing 1**

The BPAI indicated that "the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter which appellants conceded was unpatentable. ... Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule.". *Id.* at 1717. The BPAI provided an example: "... if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC<sub>BR</sub><sup>2</sup>, etc.). However, it is our view that the reissue recapture rule is not invoked for claim directed to elements ABCX, ABCD<sub>BR</sub>, ABCEF, A<sub>BR</sub>BCDEF." *Id.* at 1718.

In Ex parte Eggert, the examiner contended that “the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application in order to overcome a rejection and obtain a patent ...” (citations omitted), *Id.* at 1723. The BPAI noted that “[t]his approach ... has been expressly rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit)” *Id.* at 1723. It is clear that surrendered subject matter does not include limitations added or argued in the last amendment to the claims that became the issued claims.

### **Subject Matter Surrendered In The Original Application**

In the original application, only two independent claims were filed in the original patent, original application claims 1 and 12 (which became issued claim 14). Original application claims 1 and 12, as filed, differ from each other only in the preamble, in that claim 1 is directed to a firearm monitoring device and claim 12 is directed to the combination of a firearm with a monitoring device. The bodies of both original application claims are identical. Because of the similarity of these claims, Applicant will only specifically discuss original application claim 1.

1. A firearm monitoring device, said firearm being susceptible to recoil when discharged, comprising:

- a) first means for creating a first signal in response to substantially each recoil of said firearm; and
- b) second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means.

The original claims were rejected in the October 10, 1995, Office Action. In response, claims 1 and 12 were amended. Claim 1 was amended as follows:

1. (Amended) A firearm monitoring device for attaching to a firearm, said firearm having a firing end and a grip end, and said firearm being susceptible to recoil when discharged, comprising:

- a) first means for creating a first signal in response to substantially each recoil of said firearm; and

- b) second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means;

wherein said first means comprise an inertia switch comprising a movable mass; and

wherein said mass is resiliently biased toward the firing end of the firearm.

Claim 12 was similarly amended.

For purposes of the recapture rule as applied to pending claim 68, the surrendered subject matter is that of claim 1 as originally submitted. Using the nomenclature of the BPAI in *Eggert*, the outer circle consists of A (first means for creating a first signal in response to substantially each recoil of said firearm) and B (second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means). To obtain allowance, elements C (for attaching to a firearm), D (said firearm having a firing end and a grip end), E (wherein said first means comprise an inertia switch), F (comprising a movable mass), G (wherein said mass is resiliently biased) and H (toward the firing end of the firearm) were added. The inner circle consists of ABCDEFGH.

#### **Claims 68-75**

Claim 68 reads:

Element	Claim 68
	A firearm monitoring device
C	for use with a firearm,
D	said firearm being susceptible to recoil when discharged,
	comprising:
A	a) first means for creating a first signal in response to substantially each recoil of said firearm;
B	b) second means for receiving each said first signal and generating a second signal indicative of the number of said first signals received by said

	second means,
X	said second means configured to ignore any subsequent first signals of a series of first signals received by said second means within a predetermined time period following the receipt of an initial one of such series of first signals.

Claim 68 is represented by ABCDX, where X is a new element not present in the surrendered subject matter. Claim 68 has all the limitations of the surrendered subject matter of claim 1. The BPAI clearly indicated that this claim is not subject to the recapture rule: As discussed above, the BPAI stated that when the scope of surrender is ABC, ABCX does not invoke the recapture rule. EFGH are not required to be included to avoid the recapture rule.

Thus, claim 68, and claims 69-75 dependant therefrom, do not invoke the recapture rule, and are allowable in this application.

### **Claims 76-80**

Claims 76-80 are directed to inventions which were not claimed in the original prosecution of the issued patent. Generally, claims 76 and 77 are directed to a firearm monitoring device which has a circuit that ignores subsequent signals that follow the first signal generated in response to the discharge of the firearm. Generally, claim 78 and 79 are directed to an impulse monitor which generates at least one signal in response to an impulse occurrence, and which has a circuit that ignores subsequent signals following the first signal. Claim 80 is a method of monitoring impulses.

The issue with respect to claims 76-80 is whether these claims are directed to subject matter that the Applicant “conceded was unpatentable and abandoned or surrendered, whether by cancellation or argument of claims for the purpose of obtaining the original patent”. *Id.* at 1723. The patent specification discloses several inventions and several embodiments. In addition to the firearm monitor, the specification discloses the use of the teachings of the inventions as an impulse monitor. It discloses that the circuit can be configured to ignore multiple closures occurring within a predetermined period of time.

None of these inventions were ever the subject of any claims presented during the original prosecution. Thus, it is impossible for the Applicant to have conceded they were unpatentable, or to have abandoned or surrendered them for purposes of obtaining the patent.

The key under the recapture rule is regaining that which was surrendered in an effort to obtain allowance of the original claims. “The recapture rule ... prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims”. In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). Surrender requires not only that there be intent to give up the subject matter, but that the subject matter actually be given up.

It is axiomatic that to surrender subject matter in an effort to obtain allowance of the original claims, the subject matter must be in the claims surrendered (whether by amendment to those claims, or by argument). The subject matter of claims 76-80 was never presented, and therefore never surrendered. Thus, the recapture rule does not apply.

### **Previous Remarks**

In the previous remarks filed by Applicant on August 19, 2001, Applicant erroneously indicated that:

1. Inertia switch is broader than first means for creating a first signal (applying §112, ¶6 construction).
2. Inertia sensor is broader than first means for creating a first signal (applying §112, ¶6 construction).
3. Accelerometer is broader than first means for creating a first signal (applying §112, ¶6 construction).
4. An electrical circuit is broader than second means for receiving and generating (applying §112, ¶6 construction).

It is clear that under §112, ¶6, and Applicant expressly states that, first means for creating a first signal is broader than an inertia switch, an inertia sensor and an accelerometer for creating a first

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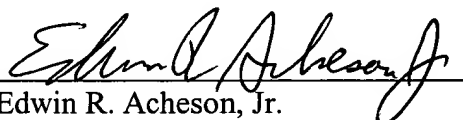
signal. It is also clear that under §112, ¶6, and Applicant expressly states that, second means for creating a first signal is broader than an electrical circuit for receiving and generating.

### **Conclusion**

Applicant believes that of the Examiner's rejections must be withdrawn and that all of the claims are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections and allow this application.

Respectfully submitted,

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### **CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to:

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this 21<sup>st</sup> day of July, 2006.

